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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,434	01/23/2004	Gerry Mavin	33775/US/RBC/VEJ	6082

32940 7590 07/27/2005

DORSEY & WHITNEY LLP
555 CALIFORNIA STREET, SUITE 1000
SUITE 1000
SAN FRANCISCO, CA 94104

EXAMINER

SMALLEY, JAMES N

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,434

Applicant(s)

MAVIN ET AL.

Examiner

James N. Smalley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-70 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/30/04; 10/8/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 7-9, 12-13, 16 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Goth US 3,269,617.

Goth '617 teaches a tamper-resistant package, comprising a container (a), an insert (1), a pull-tab (11), and a tear-away section (10) defined by a score line (9). The insert has a flange (7) that does not overlie the container sidewall (6).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 6 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Goth US 3,269,617 as applied above under 35 U.S.C. 102(b) to claim 1, in view of Hicks et al. US 5,839,627.

Goth '617 does not teach a cap snapped over a retaining formation on the container neck.

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Hicks '627 teaches retaining a cap on a container neck by a snap connection comprising neck bead (16') and cap groove (18'). It is known snap connections allow quick removal as opposed to the turning motion required by threaded connections.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cap of Goth '617, replacing the threads with a snap connection, as taught by Hicks '627, motivated by the benefit of allowing a user to remove the cap with a single upward force.

6. Claims 10-11, 23-26, 28-34, 37, 40-47, 49-55, 58 and 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goth US 3,269,617 as applied above under 35 U.S.C. 102(b) to claim 1, in view of Klesius US 5,004,126.

Goth '617 does not teach the insert being permanently adhered to the container neck.

Klesius '126 teaches a means for permanently securing an insert to a container neck, comprising a flange (12) with a groove for receiving a medium (26) to permanently secure the insert to a container neck.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the connection between the insert and container rim of Goth '617, providing the permanent connection between the insert flange and the container neck rim, as taught by Klesius '126, because such is an obvious alternative means to secure an insert to a container. It has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

7. Claims 14-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goth US 3,269,617 as applied above under 35 U.S.C. 102(b) to claims 1 and 16, in view of Adams et al. US 5,810,184.

Regarding claims 14-15, Goth '617 does not teach an annular plug disposed in the cap, to seal against the insert wall. However, the Examiner notes such sealing is taught in other embodiments of the reference.

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Adams '184 teaches an annular plug (53) disposed in a threaded cap, for sealing against the insert wall (23).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cap of Goth '617, providing an annular plug, as taught by Adams '184, motivated by the benefit of sealing about the insert opening.

Regarding claim 17, Goth '617 teaches a pull tab, but does not teach a pull ring.

Adams '184 teaches a pull ring (39) attached to a concave removable membrane (32).

It would have been obvious to modify the membrane of Goth '617, replacing the pull tab with a pull ring, as taught by Adams '184, motivated by the benefit of providing the user a means to wrap a finger around in order to aid in the removal of the membrane.

Regarding claim 18, Goth '617 does not teach a concave removable membrane.

Adams '184 teaches in col. 1, lines 27-31 that the concavity of the membrane acts as a bellows to absorb pressure and prevent damage to the membrane, should the container be accidentally compressed. Furthermore, in col. 1, lines 49-52, we are taught forming the membrane concave allows a user to more easily grip the ring, and also serves an advantage in molding the device.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the membrane of Goth '617, forming it concave, as taught by Adams '184, motivated by the benefit of providing a pressure-absorbing bellows, by the benefit of allowing a user to more easily grip the pull ring, and for advantages in molding the insert.

8. Claims 27 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goth US 3,269,617 in view of Klesius US 5,004,126, as applied above under 35 U.S.C. 103(a) to claims 23 and 44, and further in view of Hicks et al. US 5,839,627.

Goth '617, as modified, does not teach a cap snapped over a retaining formation on the container neck.

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Hicks '627 teaches retaining a cap on a container neck by a snap connection comprising neck bead (16') and cap groove (18'). It is known snap connections allow quick removal as opposed to the turning motion required by threaded connections.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cap of Goth '617, replacing the threads with a snap connection, as taught by Hicks '627, motivated by the benefit of allowing a user to remove the cap with a single upward force.

9. Claims 35-36, 38-39, 56-57, 59-60 and 64-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goth US 3,269,617 in view of Klesius US 5,004,126, as applied above under 35 U.S.C. 103(a) to claims 22, 37, 43 and 58, and further in view of Adams et al. US 5,810,184.

Regarding claims 35-36, 56-57 and 64, Goth '617, as modified, does not teach an annular plug disposed in the cap, to seal against the insert wall. However, the Examiner notes such sealing is taught in other embodiments of the reference.

Adams '184 teaches an annular plug (53) disposed in a threaded cap, for sealing against the insert wall (23).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cap of Goth '617, providing an annular plug, as taught by Adams '184, motivated by the benefit of sealing about the insert opening.

Regarding claims 38 and 59, Goth '617 teaches a pull tab, but does not teach a pull ring.

Adams '184 teaches a pull ring (39) attached to a concave removable membrane (32).

It would have been obvious to modify the membrane of Goth '617, replacing the pull tab with a pull ring, as taught by Adams '184, motivated by the benefit of providing the user a means to wrap a finger around in order to aid in the removal of the membrane.

Regarding claims 39 and 60, Goth '617 does not teach a concave removable membrane.

Adams '184 teaches in col. 1, lines 27-31 that the concavity of the membrane acts as a bellows to absorb pressure and prevent damage to the membrane, should the container be accidentally

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compressed. Furthermore, in col. 1, lines 49-52, we are taught forming the membrane concave allows a user to more easily grip the ring, and also serves an advantage in molding the device.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the membrane of Goth '617, forming it concave, as taught by Adams '184, motivated by the benefit of providing a pressure-absorbing bellows, by the benefit of allowing a user to more easily grip the pull ring, and for advantages in molding the insert.

Regarding claim 67, Goth '617, as modified, does not explicitly teach the material from which the cap is formed, though the reference does disclose the insert is to be formed of resilient plastic.

LDPE and HDPE are well known resilient thermoplastics used in the molding of container closures and inserts.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the closure cap and insert of Goth '617 of LDPE or HDPE, or any other suitable resilient thermoplastic, because it is well known to use such resilient thermoplastics in the molding of container closure caps. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the

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conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-70 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-2, 5-46 and 50-61 of copending Application No. 10/467,988. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The inventions are not patentably different as claimed.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: See attached PTO-892 citing various related references.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James N. Smalley whose telephone number is (571) 272-4547. The examiner can normally be reached on M-Th 9-6:30, Alternate Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jns



NATHAN J. NEWHOUSE
PRIMARY EXAMINER